

### **REMARKS**

Presently, claims 19-42 are pending in the application. A Request for Continued Examination ("RCE") under 37 C.F.R. §1.114 is being filed herewith. The specification has been amended to correct a formal matter noted by Applicants. Claims 1-18 have been canceled. Independent claims 19 and 25 have been amended to more clearly define the present invention. Support for the amendments to claims 19 and 25 may be found, for example, at pages 10-11 of the specification. New claims 35-42 have been added to alternatively recite the present invention. Support for the features recited in independent new claim 35 may be found, for example, in claim 25 and at the paragraph bridging pages 6-7 of the specification. Support for the features of new dependent claims 36-42 may be found, for example, in dependent claims 26-29, 31, 32 and 34, respectively. Accordingly, no new matter has been added to the application by the foregoing amendments.

### ***Examiner Interview***

Applicants and the undersigned thank Examiner Manning for the courtesies extended during a telephone interview conducted on May 12, 2005, to discuss the present application and Office Action. During the interview, the prior art and proposed amendments to claims 19 and 25 were discussed. Applicants' reasons as to why such amendments overcome the Examiner's prior art rejections were also discussed. Such reasons are detailed below.

As a result of the interview, the Examiner stated that the proposed amendments and arguments with respect to claims 19 and 25 were understood and appeared to be compelling, but reserved the right to review Applicants' arguments in detail upon submission of a formal response. In particular, the Examiner acknowledges that independent claims 19 and 25 appeared to distinguish over the combination of Tsuria and Grossman. The amendments and arguments submitted herewith include the amendments discussed with the Examiner during the interview.

### ***Specification***

The specification has been amended to correct a formal matter noted by Applicants. Specifically, Applicants have listed the formal application number a co-pending U.S. patent application that was previously incorporated by reference into the present application. The application number of the incorporated reference was not known at the time of filing of the present application. Entry of the specification amendments submitted herewith is respectfully requested.

### ***Claim Rejections – § 103(a)***

The Examiner has rejected claims 1-9 and 12-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,786,845 to Tsuria (“Tsuria”) in view of U.S. Patent No. 5,861,881 to Freeman *et al.* (“Freeman”). The Examiner has rejected claims 10-11 as being unpatentable over Tsuria and Freeman and further in view of U.S. Patent No. 6,698,020 to Zigmond *et al.* (“Zigmond”).

Although not necessarily agreeing with the Examiner, claims 1-18 have been canceled. Accordingly, the Examiner’s §103(a) rejections of claims 1-9 and 12-18 and 10-11 are moot.

The Examiner has rejected claims 19-28 and 31-34 as being unpatentable over Tsuria in view of U.S. Patent No. 5,907,321 to Grossman *et al.* (“Grossman”). The Examiner contends that Tsuria teaches a display device that includes a memory unit 30 and a processor 28 that recognizes a delay period associated with a channel change command and that retrieves a local signal from memory during “zapping periods”. The Examiner acknowledges that Tsuria does not teach or suggest the creation of a second delay period that is longer than an inherent delay period, but contends that Grossman teaches this feature, and concludes that it would have been obvious for one of ordinary skill in the art to combine the teachings of Grossman with Tsuria to result in Applicants’ claimed invention. Applicants respectfully traverse this rejection.

Tsuria teaches a cable television (“CATV”) system that provides additional services during the period of time (i.e., delay) incurred in tuning to a newly selected

channel or scrolling through a series of channels. Tsuria refers to such periods as “zapping times.” Tsuria teaches a CATV source 15 (including a zapping time message transmitter 17) that downloads advertisements to a CATV converter 12. During zapping periods, a processor 28 in the converter 12 retrieves an advertisement from the memory 30 for display on the television 14 (see column 3, lines 60-65 of Tsuria). In Tsuria, the advertisement that is displayed during the zapping time may be associated with the previously selected channel or the newly selected channel, or may be a default advertisement that is not associated with a particular channel.

Grossman teaches a system of transmitting advertising information to a subscriber unit in a CATV system. In Grossman, the subscriber units receive signals containing advertising information. Grossman teaches that there is typically a “brief delay period between the displays of sequentially displayed channels,” known as the interchannel interval (“ICI”), and that such delay typically has a duration of approximately 300 to 500 milliseconds (see column 3, lines 46-55 of Grossman). In Grossman, the visual image corresponding to the received advertising information is displayed during the ICI caused by a viewer changing channels. Grossman teaches preventing subsequent displays of an image (e.g., the advertising information) for a predetermined period of time (the interdisplay time interval) after it is initially displayed during an ICI. Thus, if a viewer changes channels more than once in relatively quick succession, in Grossman’s system the initial image is not displayed again to the viewer (unless the interdisplay time interval has expired). Grossman teaches that the duration of display of the visual image may be “any period of time consistent with the relevant legal and technical constraints” (see column 5, lines 42-45). In Grossman, it is preferable that the duration of the visual image is within the range of 100 to 350 milliseconds, since such range is a customary ICI for cable subscriber systems. The selected duration for the visual image display is programmed into the subscriber unit so that visual images may be set to the desired duration.

Independent claim 25, as amended, recites:

In a digital television environment, a method for inserting one or more local signals during an inherent delay period associated with

the execution of a channel change command, the method comprising:

recognizing the inherent delay period associated with the execution of the channel change command, wherein the inherent delay period is the time to acquire and decode a digital television signal;

transmitting a request for a local signal, wherein the local signals are stored in memory;

receiving the local signal in response to the transmitted request;

creating a second delay period which is longer than the inherent delay period; and

inserting the local signal during the second delay period.

As the Examiner acknowledges, Tsuria does not teach or suggest the creation of a second delay period or that such a period is longer than an inherent delay time. Accordingly, Tsuria does not teach or suggest all of the elements recited in independent claim 25.

Grossman also does not teach or suggest a second delay period that is longer than the inherent delay period. Grossman notes that the “duration of the display” should fit within the noted range because a) such a range is a typical ICI for cable systems; and b) anything shorter would violate the FCC prohibition against subliminal messages. Applicants respectfully disagree with the Examiner’s contention that the FCC requirement that the display duration be at least 50 milliseconds constitutes an “inherent delay period”. That is, the paragraph at column 5, lines 43-56 of Grossman does not teach or suggest that the FCC minimum display length is an inherent delay period. On the contrary, the FCC message minimum is not directed to a delay period, but to a minimum message length – the FCC minimum has nothing to do with any delay period. Moreover, Grossman is simply stating that any visual display that is inserted cannot be shorter than the FCC minimum, and therefore, that it is advantageous for the visual display to correspond to a typical ICI period, since that is the *inherent* period of delay that will be most applicable to the viewers to which Grossman’s system is directed. Furthermore, as recited in independent claim 25, the inherent delay period “is the time to

acquire and decode a digital television signal.” Thus, the only period in Grossman that could be considered to be the inherent delay period is the ICI. As such, Grossman’s ICI cannot be considered to be the “second delay period which is longer than the inherent delay period,” as recited in claim 25.

The only other delay period utilized in Grossman is the “interdisplay time interval” which is essentially a “waiting period” that must expire before the advertisement may be displayed again. The interdisplay time interval bears limited relationship to the ICI. That is, there is no requirement in Grossman that the interdisplay time interval be based in any capacity on the ICI. Therefore, Grossman does not teach that the interdisplay time interval is longer than the ICI (i.e., the inherent delay period). Even if the interdisplay time interval is longer than the inherent delay period, Grossman does not teach that the “local signal” (i.e., the visual image) is inserted within the interdisplay time interval. On the contrary, in Grossman, the visual image is always inserted within the inherent delay period – they only question is how frequently it should be displayed. Therefore, even if one were to construe Grossman’s interdisplay time interval as a “second delay period,” Grossman does not teach or suggest that such a period is “longer than the inherent delay period” nor that the local signal is inserted “during the second delay period.” Accordingly, Grossman does not teach or suggest all of the features of independent claim 25.

Not only do Tsuria and Grossman not individually teach or suggest the present invention, but, even if these references are taken in combination as suggested by the Examiner, such a combination fails to teach or suggest all of the features of claim 25. Specifically, since neither Tsuria nor Grossman teaches or suggests “creating a second delay period which is longer than the inherent delay period; and inserting the local signal during the second delay period,” the combination of Tsuria and Grossman is also lacking these features. When making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a *prima facie* case of obviousness. The Examiner can satisfy this burden only by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references in the manner suggested by the Examiner. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1998). The mere fact that the

prior art could be modified in the manner proposed by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification. *Ex Parte Dussaud*, 7 U.S.P.Q.2d 1818, 1820 (Bd.Pat.App & Interf. 1988). Applicants respectfully submit that the Examiner has not met this burden, since the Examiner has not pointed to an objective teaching or combination of references which disclose Applicants' claimed invention. Accordingly, independent claim 25 is believed to be allowable over the combination of Tsuria and Grossman.

Independent claim 19 recites "a processor for recognizing an inherent delay period associated with the channel change command, wherein the inherent delay period is the time to acquire and decode a digital television signal; and a signal insertion module...for creating a second delay period for inserting the local signal in the second delay period, wherein the second delay period is longer than the inherent delay period." For the same reasons discussed above with respect to independent claim 25, Applicants respectfully submit that neither Tsuria, Grossman, nor the combination thereof teach or suggest the features of independent claim 19. Accordingly, claim 19 is believed to be allowable over the combination of Tsuria and Grossman.

New independent claim 35 recites "recognizing the inherent delay period... wherein the inherent delay period is the time to acquire and decode a digital television signal;...and manipulating the inherent delay period such that a program associated with the second channel is delayed until the local signal is terminated." Neither Tsuria nor Grossman teaches any manipulation of the inherent delay period. Although the inserted advertisement in Tsuria may be associated with the "old" channel, the "new" channel, or a default, neither reference teaches that a program displayed on the "new" or "second" channel is delayed in accordance with inherent delay period that is manipulated to accommodate the local signal. Accordingly, for the same reasons discussed above with respect to independent claim 25, Applicants respectfully submit that Tsuria and Grossman do not teach or suggest all of the features of claim 35, taken either alone or in combination.

Dependent claims 20-28, 31-34 and 36-42 are allowable at least by their dependency on independent claims 19, 25 and 35, respectively. Reconsideration and

withdrawal of the Examiner's obviousness rejection of claims 19-28 and 31-34 are respectfully requested.

The Examiner has rejected claims 29-30 as being unpatentable over Tsuria and Grossman and further in view of U.S. Patent No. 6,698,020 to Zigmond *et al.* ("Zigmond"). As discussed above with respect to the Examiner's obviousness rejection over Tsuria in view of Grossman, independent claim 25 is believed to be allowable over the combination of these references. Applicants respectfully submit that Zigmond does not teach or suggest any of the elements missing from this combination. Thus, independent claim 25 is believed to be allowable over the combination of Tsuria, Grossman and Zigmond. Claims 29-30 are allowable at least by their dependency on independent claim 25. Reconsideration and withdrawal of the Examiner's obviousness rejection of claims 29-30 are respectfully requested.

### *Conclusion*

In view of the foregoing amendments and remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 19-42, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

Date: May 13, 2005

By: \_\_\_\_\_

Charles A. Eldering

Charles A. Eldering  
Registration No. 39,180  
Technology, Patents, & Licensing, Inc.  
6206 Kellers Church Road  
Pipersville, PA 18947  
Telephone: 215-766-2100  
Facsimile: 215-766-2920